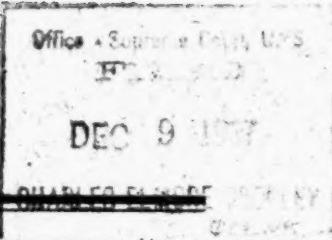


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IN THE
Supreme Court of the United States

OCTOBER TERM 1937

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No. 72
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CROWN CORK & SEAL COMPANY, INC., Plaintiff-Petitioner,

v.

FERDINAND GUTMANN & COMPANY, Defendant-Respondent.

REPLY BRIEF FOR PLAINTIFF-PETITIONER.

—
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*Footnote.

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FERDINAND GUTMANN & COMPANY, *Defendant-Respondent*.

—
REPLY BRIEF FOR PLAINTIFF-PETITIONER.

We reply herein to respondent's arguments in the order they are presented in its brief.

Respondent raises numerous defenses unrelated to the questions presented in the petition and on which the writ was granted. Each of these unrelated defenses was expressly rejected by the District Court and not discussed in the opinion of the Court of Appeals, although argued before that Court.

Although we think this Court, in view of the decisions below, will not examine these defenses, we answer them all herein, except the defense of non-invention over the prior art which we answer in a separate brief filed herewith.

I. Respondent's Argument (Br. pp. 8-13) that the Invention of the Divisional Patent Was Abandoned.

Respondent now contends that the preheating invention was abandoned and refers (Br. p. 9) to a discussion of this case by the Court of Appeals for the Second Circuit in its later decision in *Western Electric v. General Talking Pictures Corp.*, 91 F. (2d) 922, in which later case the Court¹ made the remark that Warth abandoned his invention.

Regardless of what respondent now asserts the Court of Appeals *intended* to hold in its decision in the case at bar, a reading of the decision below shows that the Court actually held the divisional patent invalid, not on a finding of abandonment, but only because of laches and unexcused delay in presenting claims. There is no reference whatsoever to *abandonment* in the Court of Appeals' decision. If that decision had been based upon a finding of abandonment, there would, of course, have been no point in the Court's statement that no "excuse appears here for delay" nor in its repeated reference to "apathy and unexcused delay" in bringing forward the divisional claims.

The distinction between laches and abandonment has been repeatedly recognized. For example, in *Utah Radio Products Co. v. Boudette* (C. C. A. 1st) 78 F. (2d) 793, 799, in discussing the applicability of *Webster v. Splitdorf*, 264 U. S. 463, the Court said:

"This is a case of laches, not of abandonment. To prove abandonment it is necessary to show an intention on the part of the inventor to abandon or give the subject-matter to the public; but where laches—unreasonable delay—is the issue, the intent is unimportant, and especially so where public rights have attached pending the delay."

Moreover, in the case at bar, the Court of Appeals based its finding upon the decision of this Court in the *Webster*

¹ By Manton, J. who dissented in the case at bar.

case, *supra*, and, in that case, this Court applied the doctrine of laches as distinguished from abandonment.

A. Abandonment was not pleaded by respondent, as required by the Statute, and therefore is not an issue in this case.

Under the Statute,¹ which we quote in the Appendix, (p. 41), abandonment must be specifically pleaded or noticed as a defense before trial. Respondent did not plead it (I, 24-31) or give the required notice. Hence, the question of abandonment was not before the Court of Appeals. Nor was it raised by assignment of error, notwithstanding the fact that the District Court found as a fact (III, 1800) that the invention had not been abandoned.

The courts have uniformly construed the Statute to mean that there must be pleading or notice of the defenses specified therein, which defenses specifically include that of abandonment. Not only is the Statute mandatory, but the courts have recognized that it is unfair to plaintiff to have such an unpleaded defense considered.

"Moreover, the defense of abandonment was not pleaded, and the appellant had no opportunity to meet it by evidence". *Mast, Foos & Co. v. Dempster*, (C. C. A. 8th) 82 Fed. 327, 331.

See also:

- Western Electric Co. v. Sperry Electric Co.* (C. C. A. 7th) 58 Fed. 186, 192;
- U. S. Electric Co. v. Consolidated* (C. C. N. Y.) 33 Fed. 869, 871;
- Warren Featherbone Co. v. Warner Bros. Co.* (C. C. Conn.) 92 Fed. 990, 991;
- Abrahams v. Universal Wire Co.*, 10 F. (2d) 838, 842 (D. C. E. D. N. Y.);
- Walker on Patents*, Sixth Edition, Sec. 499.

¹ R. S. Sec. 4920, U. S. C. Title 35, Sec. 69, Appendix, p. 41.

B. There was no intent to abandon the divisional patent invention.

Respondent refers (Br. p. 10 *et seq.*) to certain proceedings in the prosecution of the original patent as "*indications*" of intent to abandon the subject-matter of the divisional patent.

It is settled law¹ that the burden of proving abandonment rests heavily upon him who alleges it and that abandonment is a question of intent, *not to be presumed*. In *Rifle Co. v. Whitney*,¹ this Court said that, if abandonment is not proved "by express declarations of intention to abandon", **it must be proved "by conduct inconsistent with any other conclusion".²**

We will now show that Warth's conduct in prosecuting his original application not only creates no presumption of abandonment, but that, on the contrary, any possible inference of abandonment is clearly rebutted by his affirmative acts.

1.—THE CANCELLATION OF CLAIMS IN THE PROSECUTION OF THE ORIGINAL PATENT.

Respondent contends (Br. p. 10) that, since Warth originally filed, but later cancelled, certain claims (III, 1247, 1248) sufficiently broad to cover the use of *either* a pre-heated cork or a heated punch for applying heat to the spot, and accepted other claims which, we submit, the Court of Appeals unwarrantedly held to be limited to a heated punch, he intentionally abandoned any right to make claims covering *specifically* the use of a preheated cork as he later did in his divisional patent.

Respondent's argument completely overlooks the fact that these cancelled claims were so broad as to be properly

¹ *Rifle Company v. Whitney*, 118 U. S. 22, 24-25; *Kendall et al. v. Winsor*, 62 U. S. 322, 329, 331; *Beedle v. Bennett*, 122 U. S. 71, 76; *Ide v. Trorlicht*, (C. C. A. 8th), 115 Fed. 137, 144; *Saunders v. Miller*, 33 App. D. C., 456, 469; *Mast, Foos & Co. v. Dempster Co.*, (C. C. A. 8th), 82 Fed. 327, 331.

² Emphases ours throughout unless otherwise stated.

rejected by the Patent Office on prior art (III, 1253-1256). Consequently, when Warth cancelled them, he was not abandoning any part of *his invention*. Nor does such cancellation afford a basis for giving the claims which he did accept a meaning narrower than their language compels, as respondent, in effect, argues should be done. Moreover, none of the cancelled claims was specifically directed to the application of heat by means of a preheated cork.

When, therefore, petitioner now asserts that the claims which Warth did accept in the parent patent cover the application of heat by means of a preheated cork, it is not asking for any interpretation of the patent claims which will include anything which was surrendered in order to obtain the patent. Nor did Warth, when he presented his *divisional* patent claims, ask for protection for anything surrendered by claim cancellation in the prosecution of the application for the parent patent.

Hence, the cancellation of the rejected claims in the parent application creates no inference of abandonment of pre-heating and does not warrant the application of the estoppel rule. The Courts have repeatedly held¹ that estoppel arises from claim cancellation only where an interpretation is urged for the claims of the patent which would make them the same in scope as the cancelled claims.

But that is not the situation here. No single claim cancelled during the prosecution of the original patent specified, as do the claims of both Warth patents (*a*) that the spot is punched over the cork, or (*b*) that the punching operation deposits the spot on the cork, or (*c*) that, upon or at the instant of assembly, heat and pressure are applied simultaneously. To all of these steps, the parent patent claims are admittedly restricted and petitioner is not asking a broader interpretation. Moreover the claims of the *divisional* patent are *additionally* limited to applying the heat

¹ *National Hollow B. B. Co. v. Interchangeable*, (C. C. A. 8th) 106 Fed. 693, 714; *Wayne Co. v. Benbow*, (C. C. A. 8th) 168 Fed. 271, 279; *Scaife & Sons v. Falls City* (C. C. A. 6th) 209 Fed. 210, 216-217; *National Tube v. Mark* (C. C. A. 6th) 216 Fed. 507, 522.

to the spot by preheating the cork, and certainly no claims to this were ever cancelled.

To supports its argument for abandonment of preheating, respondent cites (Br. p. 13) a number of cases in which claims were refused an applicant on the ground of *res adjudicata*, corresponding claims having been rejected and abandoned in earlier applications. These decisions are not in point, since, as we have shown, the claims of Warth's divisional patent do not correspond to any claims which were rejected or cancelled in the parent application. Moreover, even if they did, the Patent Office had a right to waive the question, as this Court specifically held in *Overland v. Packard*, 274 U. S. 417, 421:

“As the Patent Office by granting the patent must be held to have waived any objection to the application on the ground that the claim allowed had been rejected before by that Office, there is no reason why the appellees below should not be allowed to avail themselves of the waiver.”

No abandonment of preheating is to be inferred from the acceptance of the parent patent claims, because, as we show in our main brief (pp. 27-29, 33-34), (a) the Court of Appeals unwarrantedly read into those claims the “heated punch” limitation, and (b) Warth reasonably believed that the parent patent claims did cover preheating, which belief was in accord with the findings of the District Court.

Whether Warth was mistaken or not, it is clear that his acceptance of the claims is not “conduct inconsistent with any other conclusion” than abandonment of preheating (*Rifle Co. v. Whitney*, p. 4 *ante* footnote), particularly since the preheating invention had been reserved by disclosure in the previously-filed 1930 divisional application.

2.—THE CANCELLATION OF THE SPECIFIC
REFERENCE TO PREHEATING IN THE
PARENT PATENT SPECIFICATION.

Respondent refers to the cancellation of the "preheating" description as "indicating" an intent to abandon any right to protect this invention and the Court of Appeals also referred to this amendment. We have shown (Main Br., p. 7) that, when Warth cancelled this specific description, he inserted the *broader* statement (III, 1272, l. 11 *et seq.*) which reads:

"The preferred method of applying the material to the cap is to utilize, at the time of assembly, both heat and pressure to unite the spot to the cork or cushion material * * *."

"In Figures 3 and 4, there is shown a suitable mechanism for applying the disc and adhesively uniting it to the cork insert at the time the strip is punched * * *";

We have also shown that Warth had previously included the preheating disclosure in his copending 1930 divisional application (III, 1668), the specification of which was identical with the original application and thus followed the practice established by the Patent Office and the Courts for preserving an inventor's right to every part of his application disclosure. See the decisions cited page 10, *infra*. Although the single claim of this 1930 divisional application (III, 1675) was directed to the strip material, the application specification states at the outset (III, 1671):

"This invention relates to a *method* of producing closures of the type in which a sealing disc has a facing."

This application is a division of my co-pending application Serial No. 159,743, filed January 7, 1927".

The copending application referred to in the above quotation was the original Warth application, and, in accordance with Warth's statement, the Patent Office duly endorsed the file (II, 669), thus formally recognizing, in ac-

cordance with the established practice, that this second application was entitled to the filing date of the original application.

Since Warth, when cancelling preheating from his original specification, *broadened*, and did not narrow, his statement of the manner in which heat is applied simultaneously with pressure, the inescapable inference is that he intended to emphasize the breadth of his invention and not to narrow it.

3.—THE ISSUANCE OF THE PARENT
PATENT WITHOUT A DESCRIPTION OF
PREHEATING AND BEFORE THE DIVISIONAL
PATENT CLAIMS WERE PRESENTED, DOES
NOT WARRANT AN INFERENCE OF INTENT
TO ABANDON PREHEATING.

Respondent cites (Br. p. 12) *McClain v. Ortmayer*, 141 U. S. 423, and *Deering v. Winona Harvester Works*, 155 U. S. 286, in support of its contention that the issuance of the parent patent, before specific preheating claims were presented, "indicates" an intent to abandon. In each of these cases, the subject-matter which was held dedicated to the public was not reserved in any copending application and was *described in the issued patent*. But the Warth parent patent did not describe preheating.

In the case at bar, Warth did exactly what this Court stated in *Overland v. Packard*, (274 U. S. 417, 420) would not warrant a holding of abandonment. In the *Overland* case, Cowles, in 1899, had filed an application disclosing more than one invention. The description of the invention in controversy was later cancelled from the application and the application went to patent on July 13, 1900. On September 6, 1901, over thirteen months after that patent issued, Cowles filed another application disclosing and claiming the invention cancelled from the earlier application and which he was charged with having abandoned. The invention was finally patented in a division of the 1901 applica-

tion, the division having been filed in 1912. This Court said (at 420) :

"We do not find in the statement of facts any circumstances which can be held to be an abandonment by Cowles of his claim for which he subsequently secured his patent."

Similarly, in *Folberth Auto Specialty Co. v. Mayo*, 292 F. 883, 894 (D. C. Ill.) the Court held that a disclosure in a patent issued more than two years patent before claims were presented in a divisional application does not constitute abandonment or dedication to the public, since *the subject-matter was disclosed in an intervening application copending with the earlier issued patent*. In the *Folberth* case, there was a description of the invention in the earlier issued patent, whereas, in the case at bar, the description does not appear in the patent.

C. To negative abandonment, the invention of a divisional patent need not have been claimed in its parent application.

So far as *claiming* preheating is concerned, it is true that Warth *might* have presented such claims in his 1930 divisional application. But the point raised by respondent for decision here, is as to whether Warth's failure to do so constitutes an abandonment of his right later to claim preheating in the divisional patent and whether the Patent Office was correct in according him, following its established practice, the filing date of his original application because he had had a disclosure of preheating continuously after his original filing before the Patent Office in patent applications.

This Patent Office practice was recognized and approved in the following cases, in each of which it was specifically held that the right to a patent is preserved, and abandonment negated, by a continuing disclosure, *even in the absence of a continuing claim*.

Ex parte Repogle, 25 U. S. Pat. Q. 121, (Pat. Off. Board of Appeals—July 23, 1932; see appendix, pp. 41-44);
Lee and Hogan v. Vreeland, 1923 C. D. 94;
Ex parte Henry, 1893 C. D. 88;
Von Recklinghausen v. Dempster, 34 App. D. C. 474, 476, 477;
Forbes v. Thomson, 1890 C. D. 61, 63;
Hopfelt v. Read, 1903 C. D. 319, 321.

As we show in our main brief (p. 14), this practice is in accord with the rule laid down by this Court in *Chapman v. Wintroath*, 252 U. S. 126, wherein the Court said that a divisional application is entitled to the "priority of right" of the parent application for any invention disclosed in it, even though it "is not claimed therein".

Respondent urges (Br. p. 9) that the case at bar resembles the *Webster v. Splitdorf* case, because, respondent says, "in each the inventor *deliberately* failed to insert a claim while having ample time and opportunity to do so and only filed his divisional application after another party had obtained a patent for the invention", and that, in each case, the action of the inventor was due, in the language of this Court in the *Webster* case, to "an exigent afterthought rather than a logical development of the original application".

But the facts in the case at bar are essentially different from those in the Webster case, as we shall now show.

Although Warth failed to present claims specific to pre-heating in his original application, there is nothing to indicate that such action was *deliberate*, as was the fact in the *Webster* case where the patentee *intentionally* refrained from making the claims, because, as this Court said (p. 465), "he considered their subject-matter one merely of design and not of invention".

Moreover, it is admitted that Warth did not present claims in the application for the divisional patent *broader* than those he presented in his original application, as was

done in the *Webster* case. The Court of Appeals held (III, 1835) that Warth's original application had claims which dominated preheating. Hence, in the case at bar, in contrast with what this Court found in the *Webster* case (pp. 465, 467), Warth did not bring "forward claims broader than those originally sought" or which were "expansions of the original claims". In view of this, it is not correct to characterize Warth's divisional application as not being "a logical development of the original application".

Again, in contrast with the facts in the *Webster* case, Warth was not inspired to present the specific preheating claims in an effort to cover what others had done or what had been in general use. As the District Court correctly found. (III, 1803-1804) :

"As soon as it came to Warth's attention that any one else was claiming the invention he, *being unaware of what methods others were using, and having no knowledge of defendant's using the preheating method*, proceeded as the statutes permitted, and in accordance with the practice recognized by the Patent Office and the courts. *Overland v. Packard Co.*, 274 U. S. 417.

"In making the claims to the preheating step Warth was covering what he had invented, *without any intent to expand his disclosures to cover later methods which had come to his attention*. This has been approved by the Courts. *Carson v. American Smelting and Refining Co.*, 4 Fed. (2d) 463, 470; *Remington Cash Register Co. National Cash Register Co.*, 6 Fed. (2d) 614; *Overland Co. v. Packard Co.*, *supra*."

Although the facts in the case at bar are quite different from those in the *Webster* case, they closely parallel the facts in *Chapman v. Wintroath*, 252 U. S. 126.

In the *Chapman* case, the original Chapman application disclosed, but did not specifically claim, the invention of the later-filed divisional application. For six years, no claims to the divisional invention had been presented by Chapman. Such claims were first presented by Chapman in a divisional application only because the *Wintroath* pat-

ent, containing these claims, had issued, the Patent Office having inadvertently failed to declare an interference between the original Chapman application and the Wintroath application, as it should have done.

Similarly, in the case at bar, Warth was prompted to present his specific preheating claims in a divisional application, because of the grant of the Johnson patent containing these claims, the Patent Office having inadvertently failed to declare an interference between the Johnson application and the original Warth application while the latter was pending. As pointed out in our main brief (p. 9), if such an interference had been declared, Warth would then, *while his original application was pending*, have had knowledge of Johnson's preheating claims, which then stood allowed, and would then have appreciated the necessity for asserting claims specific to preheating.

Like the inventor in the *Chapman* case, Warth could have presented the preheating claims earlier, had the necessity for doing so been apparent. But also like Chapman, Warth did present the preheating claims before any statutory bar had arisen and well within two years after the Johnson patent issued, as approved by this Court in the *Chapman* case.

Moreover, it would indeed be a harsh application of the equitable rule of laches to recognize Johnson's inadvertently issued patent as creating an intervening right, since the uncontradicted evidence is that Johnson, before the earliest date respondent now asserts for his machines with preheating, visited petitioner's plant where he observed the use of the Warth preheating method and thus acquired knowledge of it. (Main Br. p. 32.)

II. Respondent's Argument (Br. pp. 14-22) that the Divisional Patent is Not a Proper Division of the Warth 1930 Application and that the Latter is Not a Proper Division of the Original Warth Application.

Respondent's argument (Br. pp. 18-22; pp. 40-43) on the right of a patentee to file a divisional application "after a patent has once issued" omits consideration of what constitutes a very important fact here; that is, that before the Warth parent patent issued, he had filed a divisional application continuing the disclosure of preheating and that such divisional application was pending when the application for the divisional patent for preheating was filed. Consequently, from the filing date of the original application until the grant of the divisional patent, there was continuously before the Patent Office, in a pending Warth application, a disclosure of the preheating method.

Admittedly, if there had been no such continuing disclosure, the divisional patent would not have been entitled to the filing date of the original application.¹

The cases cited by respondent (Br. pp. 19-21) are not in point, because they merely state the rule that there must be continuity of disclosure and with this we agree. For instance, in *Spitteler v. Krische*, 1908 C. D. 374 (Resp. Br. p. 20), the Court of Appeals said that "there was no application pending in the Office as a foundation for a division." And in *Wainwright v. Parker*, 1909 C. D. 379, the Court said "there was nothing left pending before the Patent Office upon which it could act, or to which the latter application could attach". That also was the rule followed in *Gladding-McBean v. Clark*, 16 F. (2d) 50 (Resp. Br. p. 19).

On the other hand, where, as in the case at bar, **the disclosure has been continuous through successive applications, the settled Patent Office practice approved by the Courts is to give to each divisional applica-**

¹ However it would be entitled, at least, to its own filing date.

tion the benefit of the filing date of the original application.

This practice is clearly set forth in the decision of the Board of Appeals of the Patent Office in *ex parte Replogle*, 25 U. S. Pat. Q. 121 (July 23, 1932), which is quoted in the appendix, pages 41-44. In that case, there were three applications designated as A, B and C. Case C was not filed until after Case A had matured into a patent. It was copending, however, with Case B, which was filed before Case A matured into a patent. Because of this continuity of disclosure, Case C was given the benefit of the filing date of Case A. The Board of Appeals said:

“Appellant having pending in this Office a continuing chain of applications A, B and C which describe the common subject-matter and to which claims could have been directed at any time, we do not consider that there is evidence of either abandonment of the subject-matter . . . or of dedication to the public.”

The Board of Appeals also said “* * * claiming is not necessary, but only the presentation of the common subject-matter in a continuing chain of applications” to entitle the last of the three filed applications to the benefit of the filing date of the original application.

Therefore, when the Patent Office accorded Warth’s application for the divisional patent the filing date of his original application, it was following its established practice.

The practice followed by the Patent Office in the *Replogle* case was specifically approved in each of the following cases:

Benedict v. Menninger (C. C. P. A.) 64 F. (2d) 1001;
Field v. Colman, 40 App. D. C., 598.

In *Benedict v. Menninger*, *supra*, the Court accorded an application filed in 1927 the benefit of the filing date of an earlier application filed in 1923, with which the 1927 case was *not* copending, because, as in the case at bar, there had been an intervening application copending with both. The Court said (1002, 1003):

"It is conceded that both the Menninger application of May 8, 1923, and that of December 10, 1925, disclose the subject-matter of the counts, but same was not specifically claimed in either. Claims of the first may have been broad enough to include it.

"It thus appears that from May 8, 1923, Menninger has had continuously pending in the Patent Office applications disclosing the subject-matter of the counts with the right, so far as disclosure is concerned, to make the claims at any time. *Continuity of disclosure* was preserved. *Field v. Colman*, 40 App. D. C. 598; *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U. S. 390, 46 S. Ct. 324; 70 L. Ed. 651."

A. Disclosure of an invention in an application, even without a claim therefor, is sufficient basis for a divisional application for that invention.

Respondent's argument (Br. 16-17) contradicting the foregoing proposition, is directly in conflict with each of the decisions referred to, *ante* page 10, and particularly the decision of this Court in *Chapman v. Wintroath*, 252 U. S. 126, where this Court specifically said that a divisional application is entitled to the priority of the parent application even though the invention of the divisional case was "not claimed therein."

Respondent's statement (Br. p. 17) that "the Circuit Court of Appeals in the case at bar followed what we understand to be the well settled rule viz., that a divisional application to be availed of must be for the same invention and must claim it" shows clearly the error into which that Court fell.

What the Court of Appeals did was directly in conflict with the rule which has been followed for over fifty years by the Patent Office and the law as laid down by this Court in the *Chapman* case. In that case, this Court accorded Chapman's divisional application the benefit of the filing date of his original application, notwithstanding that the subject-matter of the divisional application had not been

claimed in the original application. Chapman had copied into his divisional application claims from the Wintroath patent and this Court said (p. 126) that "the combination of the Wintroath patent was not specifically claimed [in the original Chapman application]."

The decisions cited by respondent (Br. pp. 17-18) do not support respondent's contention that a divisional application must be directed to subject-matter *claimed* in the original application. *In fact, if they did, they would be overruled by the Chapman decision of this Court.*

Respondent's quotation (Br. p. 17) of a part of a sentence from the *Milburn* case is grossly misleading. Removed from its context, respondent's quotation appears to state the antithesis of what this Court actually held, namely, that a claim is *not* necessary to establish a reduction to practice date. We reproduce below the context, with respondent's quotation in brackets:

"The question is not whether Clifford showed himself by the description to be the first inventor. By putting it in that form it is comparatively easy to take the next step and say that [he is not an inventor in the sense of the statute unless he makes a claim]."

There can be no real excuse for such a deception and incomplete quotation.

In *Jones v. Larter*, 1900 C. D. 111 (Resp. Br. p. 17), the question involved was double patenting, since the earlier issued patent described and *claimed* the subject-matter which the applicant sought to protect in his second alleged divisional application. The Commissioner held (at 114):

"It would seem that these claims covering *the same thing as the claims in the prior patent* and differing therefrom only in scope cannot properly be allowed in this case. To do so would be to allow two patents to the same party covering the same invention."

After pointing out that the subject-matter was described in the original patent, the Commissioner said (at 115):

"This was clearly a case where the claims could probably be made by reissue if at all * * *."

Consequently, although the quotation from *Jones v. Lar-
ter*, as removed by respondent from its context, might appear to conflict with the practice followed by the Patent Office in the case at bar, it does not do so, *in fact*, as study of the decision clearly shows.

Nor does *ex parte Stimson*, 1916 C. D. 20, cited by respondent, (Br. p. 18) support its position. In that case, the Commissioner merely refused to permit claims for another invention to be injected into a pending application in which claims to one invention had already been allowed, since this would result in a single application with claims therein to two entirely separate and distinct inventions. But the Commissioner did not hold that *Stimson could not file a divisional application presenting such claims, and in such application, be entitled to the filing date of the pending allowed application.*

Indeed, he could not have so held without directly overruling *Hopfelt v. Read*, 1903 C. D. 319, 321, where the Commissioner had said:

*"The fact that the Office practice may prohibit the prosecution and allowance of the claims in an earlier application does not prevent an applicant from avail-
ing himself of the earlier date of filing as his date of
constructive reduction to practice when he files a later
application containing the same description and the
claims based upon the same."*

B. Warth's divisional applications complied with the Patent Office rules to the satisfaction of the Patent Office.

Respondent (Br. p 14) charges generally that Warth did not comply with the Patent Office rules as to divisional applications. It also argues that the statement in the divisional patent that it is a division of the 1930 divisional application and that that, in turn, is a division of the original application, is clearly erroneous.

Obviously, the Patent Office does not agree with respondent, since it endorsed the Warth divisional patent with

the alleged erroneous statement,¹ as shown on the face of the patent (I, 554). Furthermore, in recognition of the correctness of that statement, the Patent Office, in Warth's interference with Johnson, accorded the divisional patent the filing date of the original application (II, 660 *et seq.*).

Clearly, therefore, the Patent Office considered that the Warth 'divisional' applications sufficiently complied with its rules and procedure and they did so comply. Even if they did not do so completely, the Patent Office has waived any objection thereto, a thing which the Courts have recognized that the Patent Office may do without affecting validity of the patent. See cases cited, *post*, page 19.

Respondent also suggests (Br. p. 15) that the Warth 1930 application was not a proper division because, while the Patent Office had required claims for the adhesive *per se* to be divided out of the original application, the 1930 application claimed the adhesive as applied to a strip material.

There is no point to this criticism, since divisions may be filed even though not required by the Patent Office. In each of the cases of *Chapman v. Wintroath* and *Overland v. Packard*, divisional applications were approved by this Court, *though they had been filed without Patent Office requirement*.

Warth, therefore, was free to file a divisional application for *any separate invention disclosed in his original application*, and he was not restricted to the one referred to in the Patent Office requirement for division.

Respondent also suggests (Br. pt. 15) that Warth's statement in the original application, when cancelling the adhesive claims (III, 1251), was not notice of a possible divi-

¹ This file endorsement was pursuant to Commissioner's Orders No. 1832 and No. 2010 quoted in the appendix pp. 44, 45. As the orders show, the endorsement is an act requiring the exercise of judgment on the correctness of the specification statement that the application was a division since the orders do not permit an improper reference.

sional application on any separately patentable portion of his method, including preheating. This is wholly immaterial. **We know of no rule, decision or statute requiring an applicant to state in his application what parts of his disclosure he may, in the future, embody in divisional applications.** In fact, Rule 44 of the Patent Office¹ specifically prohibits reservation of disclosed subject-matter for a future application.

Moreover, it has always been recognized, both by the courts and the Patent Office, that procedural rules, such as those to which respondent refers and which include Rule 43 mentioned by respondent (Resp. Br. p. 57) do not affect the status of a patent issued without strict compliance therewith.

For instance, speaking of failure to comply with a Patent Office Rule relating to supplemental oaths, the Court, in *Heller Bros. v. Crucible Steel* (297 F. 39, 43; C. C. A. 3) said:

"At most, as we understand it, it is but a rule of Patent Office procedure, promulgated upon the authority of R. S. §483 (Comp. St. §745). If valid, and we deem it unnecessary to pass upon that, it has no bearing upon the question of validity of a patent when issued."

See also *Heap v. Tremont et al.*, 82 F. 449, 459, (C. C. A. 1); *Deere v. Arnold*, 95 F. 169, 170, (C. C. N. D. N. Y.).

In *Ex parte Roberts*, 1887 C. D. 61, 63, the Commissioner said:

"Rule 42 [now Rule 43] provides that when there are two or more applications pending—

relating to the same subject-matter of invention, all showing but only one claiming the same thing, those not claiming it must contain disclaimers thereof, with reference to the application claiming it.

¹ 44. A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application.

"But there is nothing in the rules, nor is there any statutory provision to the effect that a failure to file such disclaimer should deprive applicant of his right to a patent, or invalidate one issued upon the second application. The rule does not and could not constitute a statutory bar".

III. Respondent's Argument (Br. pp. 22-24) that the Johnson Patent Properly Issued Without an Interference With the Original Warth Application.

Respondent denies that allowed claim 35 of the Johnson application should have been suggested to Warth while his original application was pending and an interference declared, as asserted in our main brief (pp. 8, 9). Respondent either misses the point or is unaware of the Patent Office rules and procedure with respect to interference declarations.

Our point is that an interference should have been declared on claim 35 of the Johnson application, which stood allowed *when the Warth application was ready for allowance and before the Warth patent was issued*.

It is the practice of the Patent Office to make a search through copending applications before issuing any patent, as respondent agrees (Resp. Br. p. 24). The unassailable fact is that on December 11, 1930 when the Warth original application was allowed (III, 1288), this dominating claim 35 (II, 713) stood allowed¹ in the Johnson application and should have been suggested to Warth under Patent Office Rule 96 (Main Br., p. 43), *particularly since the Johnson application was not filed until over two years after the Warth application*.

Consequently, respondent's argument (Br. p. 24) that, when the *Johnson* patent issued, there were *then* no Warth method claims on file, is entirely beside the point. The important fact is, as we have just stated, that there was an

¹ It had been allowed in the official action of September 10, 1930 (II, 717).

evident and undeniable conflict between the original Warth and the Johnson applications when the *Warth* original application was ready for allowance and this conflict should have been settled by the declaration of an interference before the parent Warth patent issued. If that had been done, Warth would *then* have seen, and asserted the preheating claims which then stood allowed in the Johnson application and the question of priority would have been settled without delay and before the Warth parent patent issued. Certainly *petitioner* should not be charged with laches or abandonment of invention because of this inadvertent omission by the Patent Office.

IV. Respondent's Argument (Br. pp. 24, 25) that the Cancelled Preheating Description in the File of the Original Warth Patent Was a "Publication."

Respondent first argues that, since the entire file wrapper of the Warth application for the parent patent was open to the public on the grant of the patent and thus became a matter of public record, anyone examining the file would note the cancellation of the preheating matter therefrom and "would naturally assume that this matter and any claims therefore were abandoned by the inventor and dedicated to the public."

Since there is no statute or rule requiring an applicant, when cancelling subject-matter from an application, to state that he intends to file a divisional application covering such subject-matter, any such "assumption" as respondent urges would be wholly unwarranted. Therefore, respondent's suggestion as to what one *might* unreasonably assume does not justify an inference that Warth intended to abandon the subject-matter, as we show page 19 *ante*. To establish abandonment, intent must be *proved* and is not to be presumed.

Furthermore, as to the laches defense, it is immaterial whether one *might* or "would naturally" make such an assumption, since, to establish laches, it must be shown that

someone was, *in fact*, thereby misled into doing something which otherwise would not have been done (*Galligher v. Cadwell*, 145 U. S. 368, 372, 373—Main Br. p. 21). **Respondent does not even suggest that it, or anyone else, was so misled.**

The necessity for such a showing is emphasized by this Court in the *Webster* case, where, by analogy to an application for reissue, the Court said (at p. 567) that one “‘who seeks to revive his right which he has allowed to lie unclaimed’” is deprived by laches “‘from enforcing it to the detriment of those who **have**, in consequence, **been led to act as though it were abandoned’.”**

The Patent Office file wrapper is not a “printed publication” within the meaning of the statute (R. S. 4886).

Respondent (Br. p. 54) makes the wholly unwarranted assertion that the Warth parent application is a “printed publication” within the meaning of the statute (R. S. Sec. 4886), evidently intending to suggest that the cancelled pre-heating description in the original patent file is, therefore, a statutory bar to the divisional patent, being part of a “printed publication.”

An inventor’s right to a patent is not barred if the invention becomes known more than two years before he files his application provided such knowledge is not obtained from a “printed publication” or by a “public use” or “sale” of it more than two years before his application (R. S. Sec. 4886). As this Court said in *Elizabeth v. Pavement Co.*, 97 U. S. 126, 136:

“* * * It is not a public knowledge of his invention that precludes the inventor from obtaining a patent for it, but a public use or sale of it. In England, formerly, as well as under our Patent Act of 1793, if an inventor did not keep his invention secret, if a knowledge of it became public before his application for a patent, he could not obtain one. To be patentable, an invention must not have been known or used before the application;

but this has not been the law of this country since the passage of the act of 1836, and it has been very much qualified in England. *Lewis v. Marling*, 10 B. & C. 22. Therefore, if it were true that during the whole period [six years, p. 133] in which the pavement was used, the public knew how it was constructed, it would make no difference in the result."

Similarly, this Court held in *Corona v. Dovan*, 276 U. S. 358, 372, 373, that a paper read before a chemical society, but not published as a "printed publication" more than two years before the application date of the patent in suit, was not a defense under the statute.

In *Fessenden v. Wilson*, 48 F. (2d) 422, 425 (C. C. P. A.) the Court specifically held that a description in the file wrapper of a patent, but not appearing in the patent because of cancellation during the prosecution, is not a "printed publication" under the statute (R. S. 4886). The Court said:

"For obvious reasons, the filing of an application, the description of which is canceled before it results in a patent or comes to the public notice, is not such a published description of the invention as is within the inhibition of the statute. [Sec. 4886.] *Milburn Co. v. Davis-Bournonville Co.*, *supra*."

Consequently, it is not true that the file of the application for the Warth parent patent is a "printed publication" and thus a statutory bar within the meaning of the statute (R. S. 4886). Nor is it material for how long the public may have known of the preheating invention from the Warth application file before Warth filed his divisional application, since that file has no more adverse effect under the statute (R. S. 4886) than an oral description of the Warth invention or a public experimental use thereof would have had.

V. Respondent's Argument (Br. pp. 26-32) that There Were Adverse Intervening Rights Against the Divisional Patent.

In an attempt to disprove our statement (Main Br. pp. 10, 11) that there were no adverse intervening rights more than two years before the application for the divisional patent was filed, respondent asserts that machines operating according to the preheating invention were so used by it and others.

In urging this defense here, respondent asks this Court to review an issue of fact decided adversely to respondent by the District Court on conflicting evidence¹ and without contrary finding by the Court of Appeals, although respondent strenuously contended before that Court that the finding of the District Court was in error.

Every argument advanced here by respondent on the point of adverse intervening rights was expressly considered and rejected in the opinion of the District Court, who saw and heard all of the witnesses.

The District Court said (III, 1803) :

"The machines purchased by defendant from Johnson in 1928, had no preheater, and I am convinced that defendant made no further purchase² from Johnson until 1933, therefore the defendant has not proved any use of the preheating method, to anticipate the filing date of the first divisional application Nov. 7th, 1930 or the filing date of the second divisional application April 4; 1933."

¹ In its brief before the Court of Appeals, respondent said: "Plaintiff contended and the Court below found *on conflicting evidence* that the first machine bought from Johnson by defendant did not have a preheater."

² Respondent's assertion (Br. p. 27) that this statement is plain error is based on the letter rather than the obvious meaning of the Court's language. Since preheating was the subject-matter of the finding, the Court's reference to "further purchase" clearly refers only to machines with preheating. As we show, *post*, pp. 26-31, the Court's finding as to machines with preheaters is correct.

We submit that this Court should accept this undisturbed finding of fact of the District Court in accordance with the ruling in *Adamson v. Gilliland*,¹ 242 U. S. 350, 353:

"Considering that a patent has been granted to the plaintiff the case is preeminently one for the application of the practical rule that so far as the finding of the master or judge who saw the witnesses 'depends upon conflicting testimony, or upon the credibility of witnesses, or so far as there is any testimony consistent with the finding, it must be treated as unassailable' (citing) *Davis v. Schwartz*, 155 U. S. 631, 636."

Respondent argues (Br. p. 26) that, because the two lower Courts disagreed on issues *other* than intervening rights, this Court should disregard the rule of *Adamson v. Gilliland* and now re-examine the record on this fact issue of intervening rights. In support of its position, respondent cites *Thomson Spot Welder v. Ford*, 265 U. S. 445 and *Berlin Mills v. Procter & Gamble*, 254 U. S. 156. In the former case, two Courts of Appeals had reached different findings as to the fact of invention, and this Court decided that, under such special circumstance, there should be an exception to the well-settled rule, and so it examined the record to resolve the conflict. In the latter case, there had been a similar conflict of opinion as to the fact of invention, the District Court and one of the Judges of the Court of Appeals disagreeing with the other two Judges of the Court of Appeals on this fact.

Consequently, neither of the cases cited by respondent is applicable to the case at bar, where the District Court's finding was not disturbed by the Court of Appeals.

¹ The cases are uniform to the effect that this Court accepts a finding by a trial court or a master made from conflicting evidence involving the credibility of witnesses, where the finding has not been disturbed by the Appellate Court. *United States v. United Shoe Machinery Co.*, 247 U. S. 32, 37, 41; *Mason v. United States*, 260 U. S. 545, 556; *Cramer v. United States*, 261 U. S. 219, 226.

The record supports the District Court's finding that there is no proof of adverse intervening rights.

In case this Court should desire to examine the record to ascertain whether there is support for the finding by the District Court that adverse intervening rights had not been proved, we state the facts and answer respondent's arguments on the point as follows:

Preliminarily, we point out that, in order to invalidate a regularly-issued patent, proof of prior use must be free of any reasonable doubt.¹ Intervening rights are, of course, only a species of prior public use.

It should also be noted that, to prove intervening rights against the divisional preheating patent, it is not sufficient merely to show that "spotting machines" were used or sold. It must be shown that such machines were designed and operated so as to apply heat to the spot by means of a PREHEATED CORK, which is the distinctive step of the invention of the divisional patent.

1.—ALLEGED INTERVENING RIGHTS ARISING FROM RESPONDENT'S ACTIVITIES.

Respondent asserts (Br. p. 27) that certain machines purchased from Johnson and used by it in 1928 and 1929 (Exh. Q., R. p. 881, 882) had means for preheating the cork. There is no physical or documentary evidence of this. The machines in question are identified in the invoices (Exh. Q.) merely as "assembling machine", admittedly a term applied to machines used to insert *cork discs in the metal shells* of the caps and *not* to apply spots to the cork. The machines are not in evidence and no excuse was given for failure to produce them.

Respondent asserts, however (Br. p. 27), that the designation "extra head, rollfeed" on the invoices of these 1928, 1929 machines shows that "the machines had the preheat-

¹ *Cantrell v. Wallick*, 117 U. S. 689, 696; *Radio Corp. v. Radio Laboratories*, 293 U. S. 1, 8; *Barbed Wire Patent Case*, 143 U. S. 275, 284.

ing device". Obviously, the phrase "extra head, roll feed", in itself, does not identify the machine as being a "spotting" machine and much less a spotting machine utilizing preheating. Nor is there any testimony which connects this quoted phrase with either a spotting machine or one utilizing preheating. The testimony (XQ's. 479/87, (I, 260-261) cited by respondent (Br. p. 27) in no way relates to the phrase "extra head, roll feed" or even to the invoices which carry it.

The complete answer to respondent's assertion as to the September 1928-1929 machines of the invoices, Exh. Q, is to be found in the testimony of respondent's witness Johnson (I, 173) that, **prior to October 5, 1928**, when he was experimenting with a machine previously sold to Armstrong, **no machine sold by him had means for preheating the cork** (XQ. 121).

Respondent's Secretary, Cohn, testified that the mechanism in the machines of Exh. Q for applying center spots "*was the same as on the previous machine*" (I, 214, Q. 93). The "previous machine" referred to is the Exh. P. machine purchased in August, 1928 (II, 880) which, *by Johnson's own admission* (I, 13) *did not have means for preheating the cork*. Johnson's admission applies, of course, also to the September 15 machine of Exh. Q (I, 282), and Cohn's testimony indicates that *all* of the machines of Exh. Q were alike, so far as the spotting mechanism is concerned.

Furthermore, if the testimony of respondent's Vice-President, Cohn, that the Exh. Q machines had apparatus to carry out the preheating method be accepted, that leads to a flat contradiction of other testimony by Cohn, in which he is corroborated by another witness, for the following reason:

Cohn has a patent No. 1,921,808 (I, 596), which discloses a method of inserting cork discs in the metal shells, and then the application of spots to the cork, all *in the same machine*. Cohn, in answering Interrogatory 4 (I, 573), swore that the method of this machine had not been used

prior to March, 1932,¹ and Rasmussen, respondent's superintendent, corroborated this (I, 283). Moreover, Cohn, in his application oath, for the Cohn patent, had, of course, sworn² that his invention had not been in use for more than two years prior to its filing date of July 20, 1932.

If the testimony of Cohn that the 1928-1929 Exh. Q machines had preheaters be correct, then, since Cohn says (I, 214, Q. 93) that the Exh. Q machines were spotting machines and had also "mechanism for inserting cork discs into the metal shells after the manner of the Clark-Johnson type assembling machines", he is saying that these machines operated in accordance with the method of the Cohn patent. Therefore, if, as respondent now asserts, the Exh. Q machines were operated in 1928 and 1929 as preheater spotting machines, such assertion is in flat contradiction to its proofs as to the Cohn method which the same witnesses swore had not been used prior to 1932.

In any event, all of respondent's evidence as to these 1928, 1929 Exh. Q machines, is merely oral testimony of biased witnesses taken seven years after the event without even explanation of the failure to produce the machines and without any corroborating contemporaneous documentary evidence referring to the invention respondent seeks to anticipate.

Respondent further asserts (Br. 29) that the testimony of a number of witnesses and certain paper exhibits show that a large number of caps with center spots secured by gutta percha "*by the preheating method*" had been made and sold by respondent between August, 1928,³ and the date of the trial.

¹ We do not accept this 1932 date as proved. It is supported only by the oral assertions of these two biased witnesses. We use it here merely to show the conflict here between respondent's evidence and its present assertions.

² Patent Office Rule 46—Appendix, p. 44.

³ None of these witnesses even asserted that the caps were made by machines other than those obtained from Johnson and Johnson has testified that (I, 173) that no machine made by him prior to October, 1928 had preheating.

Of the witnesses and exhibits referred to by respondent, the testimony of Ketterer (I, 200) can be eliminated at once, because he merely testified to the purchase of spot crowns from respondent and made no reference to, nor indeed did he have any knowledge of, the method used in making them. The same is true of respondent's Exhs. NNN to TTT (III, 1519-68), because these are merely invoices for spot crowns and, of course, throw no light on their method of manufacture.

The testimony of Cohn (I, 214) we have discussed *supra* and have shown (1) that, if accepted as proving the 1928-1929 machines of Exh. Q to have been spotting machines, it is inconsistent with the Cohn's application oath and sworn answer to Interrogatory 4, and (2) that, in any event, it proves that these machines to have had means for applying the spots like earlier-purchased machines which admittedly did not use preheating.

The testimony of Cohn at I, 258, 259 and Eisen at I, 294 and Rasmussen at I, 281, refers only to a different method to which respondent was obliged to resort, in 1928 at least, for a secondary treatment of *already*-manufactured spot crowns made on a machine purchased from Johnson in July, 1928 and which admittedly did not use preheating. **In other words, this testimony cited by respondent has no bearing whatsoever upon the use of the preheating invention.**

Respondent (Br. p. 30) also refers to its Cohn patent 1,921,808 (I, 596), but does not state what bearing it has on the issue of intervening rights. This Cohn patent was not even applied for until July 20, 1932, less than a year prior to the filing date of the Warth divisional patent and, therefore, is not a bar to the Warth patent under the doctrine of *Chapman v. Wintroath*, or under the statute (R. S. 4886). Furthermore, as has been shown, respondent's proofs are that the method of this patent was not used prior to 1932.

2.—ALLEGED INTERVENING RIGHTS ARISING FROM JOHNSON'S ACTIVITIES.

Respondent also contends that the record shows sale and use by others than respondent, of Johnson machines embodying preheating more than two years prior to the filing date of the application for the divisional patent. Rejecting this contention, the District Court held (III, 1803) :

"There is no evidence to show that the Johnson machines sold to others than plaintiff and identified on the list had a preheater, or what was their construction, aside from Johnson's statement, which he changed under cross-examination."

Johnson testified (I, 171-173) that, in March, 1928, he sold a machine to a Cuban concern. He admits that this machine did not utilize preheating the cork. He also testified that, in April 1928, he sold a machine like the Cuban machine to the Armstrong Company. The Armstrong machine was returned as unsatisfactory. According to Johnson's testimony, partially quoted by respondent (Br. 28), Johnson attempted to make this returned machine work. In a letter (Exh. 36—II, 609) written October 5, 1928, Johnson had said:

"* * * I now have to see what I can do in regard to not having the tinfoil discs stick to the punch."

Johnson also said (I, 173) that he installed two heaters in front of the punch and that he did this about October 5, 1928.

There is no documentary or other physical contemporaneous proof to substantiate Johnson's statements nor is he corroborated by any other witness. Johnson testified that he did not return the machine to Armstrong (I, 172), but that he "made some changes on it" and "sent it to some other customer" (X-Q. 112). The record is silent as to (a) *what* changes were embodied in the machine alleged to have been "sent", (b) *when* the machine was completed and

used (use being essential to anticipate a method), and (c) *to whom* the machine was shipped.

Johnson's uncorroborated oral testimony, seven years after the event, falls far short of proving public use or sale of a particular invention.

In an attempt to support Johnson and prove the sale of other machines by Johnson, respondent (Br. 28, 29) refers to certain affidavits (Exh. U-II, 901-918) filed in the Patent Office in connection with a petition to institute public use proceedings. Not one of these affiants¹ was called as a witness and, obviously, affidavits of this character are not evidence as to the truth of the facts set forth therein. Exhibit U merely proves that such affidavits were filed in the Patent Office.

VI. Respondent's Argument (Br. pp. 30-32) that Petitioner Knew in 1930 that Respondent Was Making and Selling Center Spot Caps and Should Have then Ascertained the Method Respondent Was Using.

While it may be true that respondent was selling center spot caps in 1930 and that this was called to the attention of some of petitioner's employees, that is wholly immaterial as to any issue here.

Obviously a center spot crown does not, *per se*, show how it is made and, in particular, it does not show how or when the heat is applied to the spot in the manufacture of the crown. In fact, *petitioner* was making and selling spot crowns *before Warth's preheating invention*, so that, clearly, the mere existence of a spot crown does not even suggest that a preheating method was used in its manufacture.

Obviously, respondent recognizes this to be the fact, and so it asserts (Br. p. 31) that "It was petitioner's duty to have then ascertained what method respondent was using".

¹ Except Johnson who identified his affidavit (I, 165) but contradicted the same under cross-examination (I, 173).

Respondent does not explain wherein this "duty" arose nor *how* such knowledge was to be obtained. Respondent's caps are manufactured in its own plant and certainly there is no suggestion that petitioner had access to that plant or any right to invade it.

Respondent's statements (Br. p. 32) as to the visit of petitioner's Vice-President and counsel to respondent's plant on August 8, 1933, is entirely beside the point because the Warth preheating divisional application had been filed previously (April 4, 1933) so that any information obtained by petitioner's officer at the time of that visit is wholly irrelevant on the question of laches. The uncontradicted testimony (I, 521) is that, prior to filing the divisional pre-heating application, petitioner had no knowledge of the method respondent was using.

VII. Respondent's Argument (Br. pp. 33-35) that Petitioner's Laches Began With Johnson's Building of Machines for Petitioner in 1929.

Prior to 1929, petitioner's spotting machines had been built in its own plant (I, 521). In 1929 petitioner needed additional machines for its Canadian plant and had Johnson build them (I, 522). These machines were simply tested and shipped to Canada (I, 423).

Respondent suggests that the machines differed considerably in construction from the machines used prior to that date by petitioner. There is nothing in the record to support this assertion, but, even assuming that the machines corresponded to the Johnson patent, it will be evident that the spotting mechanism substantially corresponded to petitioner's earlier-built machines. The District Court did *not* find that the machines are "radically" different, as suggested by respondent (Br. p. 34).

In any event, it is quite immaterial whether the machines supplied by Johnson corresponded to machines petitioner had previously built, since, in constructing them, Johnson was merely acting for petitioner.

There is no proof that Johnson had previously built, or was at that time building, preheating machines for others.

As we have shown (Main Br. 22-23) *use* of the preheating invention by petitioner more than two years before filing the divisional application did not invalidate that patent. Clearly, if the patent was not invalidated by petitioner's *use*, it was not invalidated by petitioner's building machines for such use, and it is equally clear that the legal effect was the same when it had its machines built for it by someone else at another plant.

VIII. Respondent's Argument (Br. pp. 36-39) that Its Purchase of Machines from Johnson Before the Issue of His Patent Gives Respondent a License Under the Warth Divisional Patent.

A. The Warth-Johnson interference.

Respondent contends that, because it purchased machines from Johnson before the Johnson patent issued and petitioner later purchased the Johnson patent, respondent has a license under Warth's divisional patent claims which were awarded Warth by the Patent Office in an interference with the Johnson patent.

In making this argument, respondent insinuates that the Johnson-Warth interference was a collusive proceeding.

It is not a fact, as respondent asserts (Br. p. 36), that the Warth-Johnson, interference was not *bona fide*. It was instituted before petitioner purchased the Johnson patent. The agreement to purchase the patent was entered into on December 12, 1933 (II, 925), whereas the interference had been previously declared on April 20, 1933 (III, 1337), and petitioner did not receive title until after the interference terminated (p. 34 *infra*, footnote).

The record shows that Johnson, in order to avoid litigation, sold his patent to petitioner while the interference was pending (I, 164; 334) and received a license under the Warth parent patent, as well as under claims which might

be obtained by Warth in the interference.¹ In accordance with a stipulation, the matter was then submitted to the Patent Office (III, 1616) on a record involving, as the only issue, whether the original Warth application filed in 1927 disclosed the subject-matter of the claims, which respondent now admits was the fact. The Examiner of Interferences held that the original application disclosed preheating, and, accordingly, awarded priority to Warth (III, 1660).

The charge of collusion was made before the District Court and also before the Court of Appeals. The District Court found that the award of priority was in accordance with the facts and that petitioner acted as it should have done in submitting the matter for final decision to the Patent Office (III, 1880-1802).

It simply is not the fact, as respondent asserts, (Br. p. 36) that petitioner "could have and should have," under Patent Office Rule 94, determined by election the question of priority between Johnson and Warth. Under the rule, petitioner could not have elected in favor of Warth since the Johnson patent had issued. The decision of the Commissioner in *Chillis v. Weisberg*, 1928 C. D. 24, cited by the District Court (III, 1801) so interprets the rule and that decision fully supports the action of petitioner in submitting the matter for determination by the Patent Office as it had to do, under the decision, knowing that Warth was the prior inventor.

Although now attacking the interference as collusive, respondent has not even attempted to offer evidence showing invention of preheating by Johnson prior to the filing date of the original Warth application. The admitted disclosure of the invention by Warth in his original application, therefore, under the rule of this Court in *Chapman v. Wintroath*, *infra*, establishes him as the prior inventor.

Respondent's attack upon the Warth-Johnson interference, therefore, is without merit, since it does not question

¹ Under the agreement with Johnson, the assignment of the Johnson patent and the license to Johnson were put in escrow (I, 335) until final determination of the interference in the Patent Office. It remained in escrow until the Patent Office awarded the claims to Warth, the Patent Office being fully informed as to the situation (I, 335). The District Court so found (III 1800, 1801).

the propriety of the award to Warth or the fact of Warth's 1927 application disclosure of the preheating invention which is the basis for that award.

B. Respondent's claim to a license.

Respondent first says that it is licensed under the Johnson patent by reason of the purchase of machines from Johnson before the Johnson patent issued.

Then, in some way not clear to us, respondent proceeds to the conclusion that it is also licensed under the Warth divisional patent, because the Johnson patent is now also owned by petitioner.

We have already shown that Warth preceded Johnson by nearly two years, and, therefore, is clearly the inventor of the subject-matter of the divisional patent claims. Consequently, such claims were invalid in the Johnson patent, as the record plainly shows.

Respondent's claim to a license is based solely upon its relationship with Johnson, *i. e.*, the purchase of machines from him. Obviously, any license which respondent obtained by such purchase could not extend beyond inventions which Johnson owned. He did not own the preheating invention, since the Patent Office found that the claims thereto in the Johnson patent were improperly granted to Johnson and that Warth was the prior inventor. In other words, by the interference decision, the preheating claims of the Johnson patent were, in effect, cancelled from the Johnson patent. *Petitioner's ownership of the preheating invention is not through the claims thereto improperly issued in the Johnson patent, but through the grant of such claims in the Warth divisional patent.*

Petitioner was in no wise a party to the transaction between Johnson and respondent or to the improper issuance of the preheating method claims in the Johnson patent. Therefore, when petitioner acquired the Johnson patent after the preheating method claims, in effect, had been cancelled therefrom (*ante*, p. 34, footnote), that transfer

gave respondent no rights under petitioner's preheating invention which Johnson did not and never had owned.

If respondent were being sued on the *Johnson* patent, the defense of license might apply, and the decision cited by respondent (Br. p. 36) would be in point. But this suit is on the *Warth* patent, and respondent's plea of license thereunder is really that the purchase of the *Johnson* patent by petitioner gave respondent greater rights than it had previously derived from *Johnson* or which *Johnson* had ever been in a position to give.

In *Hartford-Empire v. Nivison*, 58 F. (2d) 701, 705, 706 (C. C. A. 6th), the facts were the same as in the case at bar and the same contention made by respondent here was rejected. The Court said:

"It is claimed that the defendant occupies the status of a licensee. The trial court denied the contention. It is true, of course, that the defendant as purchaser of a Miller feeder acquired a right or license to use that feeder under any patents owned by Miller, who manufactured the feeder, or under any patents of the Miller Glass & Engineering company, which sold the feeder to the defendant. It is, however, equally true that the purchase of the Miller applications by the plaintiff did not give the defendant, as licensee of Miller, any license to other patents or applications outstanding, and the suit here in question is upon a patent in which Miller had no property interest and which, rightly or wrongly, was held in the Patent Office to take precedence over the Miller applications. As to whether the plaintiff obtained this ruling in the Patent Office by the use of unfair methods is not for us to determine. For present purposes we accept the Patent Office ruling, in view of which it cannot be held that the license obtained by the defendant in the purchase of the Miller feeder included the right to use such feeder as against a patent issued upon an application in which Miller had no interest."

Just as in the *Hartford-Empire* case, respondent here is asserting that the finding of the Patent Office in favor of

Warth was obtained wrongfully. But respondent had full opportunity to show that the Patent Office award was in error and offered no evidence to support such a contention. On the contrary, it admits Warth's prior inventorship, since it concedes that Warth disclosed the invention in his original application long prior to any date claimed for Johnson.

IX. Respondent's Argument (Br. pp. 44-47) Denying Infringement of the Reissue Patent.

Respondent contends that, since it applies heat to the spot by a heated cork, instead of a heated punch, it does not infringe the claims of the reissue patent, and that the Court of Appeals was correct in limiting those claims to a heated punch. In our main brief (pp. 26-32), we have pointed out the error of the Court of Appeals in so limiting the claims.

Respondent has not replied to our analysis of the claims or attempted to justify the Court of Appeals' erroneous interpretation of the claim language discussed in our main brief (p. 27). Respondent takes exception only to our statement that the heated punch was not originally described in the parent Warth application, and, contradicting this assertion, quotes the following language which appeared (III, 1246) in the original specification:

"In carrying out the invention according to what is now considered the best practice the coating will be softened by heat after the crown is assembled. This may be accomplished in any suitable manner, as by a *heated plunger* or a *plunger and heated table*. The heat softens the coating and renders it adhesive and the pressure serves to unite the metal foil spot to the cork."

Respondent evidently interprets the reference to a heated *plunger* to be equivalent to a disclosure of a heated *punch*. In so doing, it overlooks the fact that the sentence referring to the heated *plunger* deals with the application of heat and pressure "*after the crown is assembled*." That is to say,

this sentence refers to what occurs at the station *following* the punching operation. (See drawing opposite page 5 of our main brief—"Fourth Step"). It was so interpreted by the Patent Office in the prosecution of the Warth divisional application after a question had been raised (III, 1445), as to the justification for the showing of the heated *plunger*, in Figure 6 (III, 1465) of the application drawing, which plunger was described (III, 1434) as "additional pressure means which may be utilized following the action of the punch." Warth's attorneys pointed out to the Patent Office (III, 1455) that this reference to a "heated plunger or a plunger and a heated table" has to do with the operation at the station *following* the punch, and not at the punching station, and the Patent Office agreed.

We have already pointed out (*ante*, pp. 4, 5) that there is no file wrapper estoppel arising out of claim cancellation to compel a limited meaning to the reissue claims and, therefore, need not discuss respondent's arguments on this point under infringement.

Nor need we discuss respondent's statement (Br. 45) as to the effect of an inventor's belief in the scope of his claim as an excuse for delay. That we have fully discussed in our Main Br. pp. 24-26; 33, 34.

Under the guise of support for the assertion (Br. p. 45) that respondent has always used "a cold cutting plunger," respondent's brief (pp. 45, 47) repeats its argument, rejected below, as to an alleged prior use of the Warth invention by respondent in 1924. Respondent uses the question of infringement as an excuse for rearguing rejected evidence of an alleged prior use which the District Court (III, 1788) described as "a temporary makeshift, which was abandoned as soon as it [respondent] was able to perfect the making of the White Rock [mechanically held spot] crown." While several witnesses were examined by respondent in connection with this defense, on the vital point as to the *method by which the spots were adhered to the corks*, respondent's proofs consisted only of the oral

testimony of *two witnesses*, namely, its Secretary, Cohn, and its Superintendent, Rasmussen, given ten years after the alleged defense, based entirely on recollection and without one scintilla of contemporaneous physical corroborating evidence.

The District Court who saw and heard the witnesses fully discusses their testimony (III, 1788, 1789) and rejected this prior use defense on the ground that the:

"testimony is too uncertain, based only on recollection of what is alleged to have happened ten years before, to furnish proof beyond reasonable doubt, to anticipate the Warth method patents in issue."

The Court further said that whatever respondent did in 1925 was, at most, "an abandoned experiment".

This finding was not disturbed by the Court of Appeals, although the defense was fully presented by respondent before that Court in its attack upon the validity of both patents.

We submit that the rule in *Adamson v. Gilliland* (p. 25, *ante*), is particularly applicable here since it is the defense to which the rule was applied in that case. To present all of the facts as to this defense would unduly lengthen this brief, but if the Court desires to examine the record to ascertain whether the undisturbed finding of the District Court was justified, we ask leave to submit a brief thereon.

X. Respondent's Argument (Br. pp. 47-53) that the Warth Patents in Suit Involve no Invention Over the Prior Art.

This defense is so foreign to any questions on which the grant of the writ herein was predicated, that we believe there is no reason for the Court to consider it. The defense was fully exploited in the lower Courts by respondent, and the District Court found against respondent, which finding was not disturbed by the Court of Appeals. The District Court's opinion (III, 1785-1787; 1789;

1790; 1797-1799) contains a full discussion of the prior art on which respondent relies.

If, however, this Court desires to examine this defense, we refer to a separate brief on it which we are filing herewith.

Conclusion.

It is submitted that, for the foregoing reasons, and those set forth in our main brief, the decision of the Court of Appeals below was in error, and that the Court of Appeals should be reversed and the case remanded to the District Court for the Eastern District of New York with instructions to enter a final decree holding both Warth patents valid and infringed.

Respectfully,

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APPENDIX.**U. S. C., Title 35, Sec. 69 (R. S. Sec. 4920):**

In any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters: * * *

Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, *or had been abandoned to the public.*

Ex Parte Replogle, 25 U. S. Pat. Q. 121, (Pat. Off. Board of Appeals—July 23, 1932):

* * * The Examiner has rejected practically all of the claims under rejection on either or both of two former patents of appellant. The first patent is #1,345,550, patented July 6, 1920, and filed June 5, 1916. This patent shows a cleaner nozzle supported on casters having spring connected thereto fitted within pockets of the nozzle structure and these casters are so related to the mouth of the nozzle that air can pass by the casters and into the opposite ends of the nozzle mouth. The patent does not disclose the stroker elements nor the brush shown in the present application. Replogle Patent #1,541,280, issued June 9, 1925, filed August 1, 1924, discloses the spring supported caster as an independent element and the specification states it might be attached to hassocks, carpet sweepers or articles of furniture which are customarily subjected to sliding around the floor of living apartments.

Appellant has referred to a number of applications previously filed by him which are said to be a continuing series of applications all relating to various features of the suction cleaning apparatus. Appellant relies upon this continuity of applications to overcome the two above referred to Replogle patents used by the Examiner as the principal references in the case. Three of these applications are re-

ferred to more particularly. Appellant designates as case A the application which eventuated in patent #1,345,550 and as case B an application, Serial #279,467, which eventuated into patent #1,533,271. This latter application was filed February 26, 1919, and the patent issued April 14, 1925. This latter patent was issued just one month later than the date of the present application, case C, March 14, 1925. These two former applications form a continuing chain to the present application of certain common subject matter disclosed in them. The Examiner apparently concedes that the intermediate application, case B, discloses subject matter common to cases A and C. The Examiner holds that it is necessary for appellant to prove the presentation of a *continuing line of claims to the subject matter herein presented from a time just previous to July 6, 1922, to the filing of the present application.* This date, July 6, 1922, is fixed by two years publication of this subject matter by the granting of the Replogle patent #1,345,550 in July 6, 1920.

Appellant urges that such *claiming* is not necessary but only the presentation of the common subject matter in a continuing chain of applications and relies particularly to support his contention on the decisions in Folberth Auto Specialty Co. v. Mayo-Skinner Mfg. Co., 292 F. 893, and in Hartford Empire Co. v. Obear-Nester Glass Co., 39 F. (2d) 769. The first decision decided the question of two years do not run prior to the date of bar to a divisional application, when the two years do not run prior to the date of the parent application. In the latter decision, it was held that amendments of claims and filing of divisional applications is allowable more than two years after the original application is filed or after the last preceding divisional application is made, but if a stranger obtains a patent more than two years after the original application was filed, then applicant may not amend his original claims (so as to broaden them) nor file a divisional application embracing such claims after two years from date of patent to the stranger.

In accordance with these decisions an apparent statutory bar to the allowance of a divisional application to be effective **must also be a bar to the earlier parent application and a divisional application may be filed at any time**, provided a stranger does not claim the subject matter of the divisional claims in a patent more than two years prior to the assertion of such subject matter in the divisional case.

In the present situation, neither of the applications A, B and C are divisional of the other, but have common subject matter and are therefore continuations-in-part. There seems to be no doubt that appellant would obtain the benefit of the earliest filing date as a constructive reduction to practice of this common subject matter in an interference, *Field v. Colman*, 1913 C. D. 221. We believe that similarly appellant because of the continuity of applications A, B and C should not be held to be barred from claims to subject matter disclosed in all three.

In accordance with the doctrine announced in *Mullen & Mullen*, C. D. 1890-9, especially as to the third class of cases therein defined, there is no presumption of dedication to the public if claims to a separate invention are not presented after a patent showing but not claiming such invention was issued and there is no bar of two years' public use or sale nor actual abandonment. By the filing of application #427,088 which presented claims to the subject matter of the character presented on appeal, as well as application B, #279,467 (patent #1,533,271) **disclosing this subject matter but not claiming it**, appellant refuted the presumption of dedication to the public of all subject matter not claimed in patent #1,345,550, and appellant having pending in this office in a continuing chain applications **A, B and C** which described the common subject matter and to which claims could have been directed at any time, we do not consider there is evidence of either abandonment of the subject matter, even though application #427,088 was abandoned, or of dedication to the public. While the decisions referred to

above relate to divisional applications, we consider that even if the applications are not divisional, but contain common subject matter, that the apparent bar of two years publication should not be applied if it may not be applied to the earliest application in the chain of continuing applications disclosing common subject matter and there is no other evidence of abandonment or dedication to the public and no evidence of intervening rights of some other patentee. We note in this connection the decision in *Lee & Hogan v. Vreeland*, 317 O. G. 233. We hold that the rejection on the earlier Repleglo patents #1,345,550 and #1,541,280 is not warranted. * * *

Patent Office Rule 46:

* * * In every original application the applicant must distinctly state under oath that to the best of his knowledge and belief the invention has not been in public use or on sale in the United States *for more* than two years prior to his application * * *

Commissioner's Order No. 1832:

December 3, 1909.

When an application is found to be a division of one previously filed, the examiner will make an entry on the face of the file wrapper, in the place indicated thereon for such entry, of the serial number and filing date of the original application. The headline of the printed specification and the record of assignments will conform to this entry.

Commissioner's Order No. 2010.

October 18, 1912.

When an application is filed which *in the opinion of the examiner* is a division of, a continuation of, or a substitute for a previously filed application but which contains no reference in the specification to such prior application, the examiner will require the applicant to insert the proper reference to the prior application in the specification. If when the case is otherwise in condition for allowance, the request has not been complied with *or has been improperly made*, the proper reference to the prior application will be made by examiner's amendment and the case passed to issue forthwith.